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MAILED

OCT 21 2011

OFFICE OF PETITIONS

In re Patent No. 6,934,515 :
Issue date: August 23, 2005 :
Application No. 09/891,234 :
Filed: June 27, 2001 :
Attorney Docket No. P-3354-US :
For: ELECTROMAGNETIC RADIATION
ALERTING DEVICE FOR USE WITH A
CELLULAR TELEPHONE

ON PETITION

This is a decision on the petition under 37 CFR 1.378(b), filed September 21, 2011, to accept an unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400. The petition for reconsideration should include an exhaustive attempt to provide the lacking item noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

The patent issued August 23, 2005. The 3 ½ year maintenance fee could have been paid from August 23, 2008 through February 23, 2009, or with a surcharge during the period from February 24, 2009 through August 23, 2009. The Office has no record of timely receiving the 3 ½ year maintenance fee. Accordingly, the patent expired on August 24, 2009.

Statute and Regulation

37 CFR 1.378(a) provides that the Director may accept the payment of any maintenance fee due on a patent based on an expiration of the patent, if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable or unintentional. The appropriate surcharge set forth in § 1.20(i) must be paid as a condition of accepting payment of the maintenance fee. The surcharges set at 37 CFR 1.20(i) are established pursuant to 35 U.S.C. 41(c) and, therefore, are not subject to small entity provisions of 35 U.S.C. 41(h). No separate petition fee is required for this petition. If the Director accepts payment of

the maintenance fee upon petition, the patent shall be considered as not having expired but will be subject to the intervening rights and provisions of 35 U.S.C. 41(c)(2).

The patent statute at 35 U.S.C. 41(c)(1) provides as follows:

"The Director may accept the payment of any maintenance fee required by subsection (b) of this section... at any time after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable."

The statute's promulgating rule, 37 CFR 1.378(b), provides that any petition to accept the delayed payment of a maintenance fee must include the following:

- (1) the required maintenance fee set forth in 37 CFR 1.20(e) - (g);
- (2) the surcharge set forth in 37 CFR 1.20(i)(1); and
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Such a statement must be verified if made by a person not registered to practice before the Patent and Trademark Office. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement.

Opinion

In the instant petition, petitioner asserts that the delay in payment of the 3 ½ year maintenance fee was unavoidable because both the assignee, Wireless Avionics LTD, and the patentee were not aware of any maintenance fee coming due. Patentee asserts the Office did not timely change the maintenance fee address, despite previous receipt on April 20, 2006 of a withdrawal of power of attorney and change of correspondence address document. Patentee did not receive any notice that a maintenance fee was coming due or a notice of patent expiration. Patentee argues the payment delay under these circumstances is therefore unavoidable.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

Petitions for the delayed payment of maintenance fees under 35 U.S.C. 41(c)(1) are treated under the same standard as petitions for revival of abandoned applications under 35 U.S.C. 133

because both statutory provisions use the same language, i.e., “unavoidable” delay. Ray v. Leyman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm’r Pat. 1988), aff’d, Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff’d, 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992)). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable as follows:

The word ‘unavoidable’is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-515 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm’r Pat. 31, 32-33 (Comm’r Pat. 1887); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-168 (D.D.C. 1963), aff’d, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm’r Pat. 139, 141 (1913)). In addition, decisions on revival are made on a “case by case basis, taking all the facts and circumstances into account.” Smith v. Massinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). The requirement in 35 U.S.C. 133 for a showing of unavoidable delay requires not only a showing that the delay which resulted in the abandonment of the application was unavoidable (or expiration of the patent as it applies to 35 U.S.C. 41(c)(1)), but also a showing of unavoidable delay from the time an applicant becomes aware of the abandonment of the application until the filing of a petition to revive (or a petition under 37 CFR 1.378(b) to reinstate the patent under 35 U.S.C. 41(c)(1)). See In re Application of Takao, 17 USPQ2d 1155 (Comm’r Pat. 1990). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable.” Haines v. Quigg, 673 F. Supp. 314, 316-317, 5 USPQ2d 1130, 1131-1132 (N.D. Ind. 1987).

When the issue of reinstatement is addressed, one must consider the actions of the party who was responsible for timely paying the maintenance fee. See Kim v. Quigg, 718 F.Supp. 1280, 1284, 12 USPQ2d 1604, 1607 (E.D. Va. 1989). Wireless Avionics LTD, the owner/assignee of the entire interest in the patent when the fee was due, was free to deal with the patent as it willed. See Garfield v. Western Electric Co., 298 F.Supp. 659 (S.D.N.Y. 1924).

The petition asserts that a failure to receive a maintenance fee reminder from the Office contributed to the delay and renders the delay unavoidable.

As a courtesy, if Office records indicate a maintenance fee has not been paid after half of the year during which it can be paid has passed, the Office normally sends a maintenance fee reminder to the address of record. Congress has not passed legislation requiring the PTO to send maintenance fee reminders. The Office sends these reminders at its complete discretion and

could discontinue the practice at any time.¹ The ultimate responsibility for keeping track of maintenance fee due dates lies with the patentee, not the Office. Id.

Since the inception of maintenance fees, the Office has maintained that it has no duty to notify patentees when their maintenance fees are due, and that the lack of any Office notice will in no way shift the burden of monitoring the time for paying the maintenance fees from the patentee to the Office. Since the mailing of Notices by the Office is completely discretionary, and not a requirement imposed by Congress, accepting an argument that the failure to receive a Notice is unavoidable delay would result in all delays being unavoidable should the Office discontinue the practice of sending reminders. All petitioners could allege non-receipt of the reminder, and therefore all petitions could be granted. This was clearly not the intent of Congress in the creation of the unavoidable standard.

Per 37 CFR 1.378(b)(3), a late maintenance fee will not be accepted unless a petitioner can demonstrate that steps were in place to monitor the maintenance fee. In Ray v. Lehman, 55 F.3d 606, 609; 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995), the petitioner had no steps in place to timely pay the maintenance fee. The petitioner argued that the PTO's regulations requiring such steps created too heavy a burden. The court stated, "Ray also takes issue with the PTO's regulation . . . arguing that it 'creates a burden that goes well beyond what is reasonably prudent.' We disagree. The PTO's regulation merely sets forth how one is to prove that he was reasonably prudent, i.e., by showing what steps he took to ensure that the maintenance fee would be timely paid, and the steps taken in seeking to reinstate the patent. We do not see these as requirements additional to proving unavoidable delay, but as the very elements of unavoidable delay." Id.

Furthermore, the Letters Patent contains a Maintenance Fee Notice that warns that the patent may be subject to maintenance fees if the application was filed on or after December 12, 1980. Accordingly, a reasonably prudent patentee would have inquired to see if his/her patent was subject to maintenance fees.

Petitioner has not shown the delay was unavoidable. Therefore, the petition is **dismissed**.

Petitioner will not receive future correspondence related to maintenance fees for the patent unless a "Fee Address" Indication Form (see PTO/SB/47) and Request for Customer Number (see PTO/SB/125) are submitted.

Regarding fees, petitioner has paid the \$700.00 surcharge and the \$490.00 maintenance fee twice. Petitioner's credit card will be credited \$1,190.00.


¹ "Congress expressly conditioned §§ 133 and 151 [of the United States Code] on a specific type of notice, while no such notice requirements are written into § 41(c) ... [T]he Commissioner's interpretation of 'unavoidable' and of the PTO's duty to provide reminder notices then, do not plainly contradict the statute. For this reason, we must accord deference to the Commissioner's no-timely-notice interpretation." Ray v. Comer, 1994 U.S. Dist. LEXIS 21478, 8-9 (1994), *aff'd* on other grounds Ray v. Lehman, 55 F.3d 606, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citing Rydeen v. Quigg, 748 F. Supp. 900, 905 (1990), Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 81 L. Ed. 2d 694, 104 S. Ct. 2778 (1984)). "The Court concludes as it did in Rydeen, that as a constitutional matter, 'plaintiff was not entitled to any notice beyond publication of the statute.'" Id. at 3 (citing Rydeen v. Quigg, 748 F. Supp. at 906, Texaco v. Short, 454 U.S. 516, 536, 70 L. Ed. 2d 738, 102 S. Ct. 781 (1982)). See also MMTC, Inc. v. Rogan, 569 F. Supp. 2d 657 (E.D. Va. 2004).

If petitioner does not wish to pursue reinstatement of this expired patent, petitioner may request a refund of the \$490.00 maintenance fee and the \$700 surcharge fee submitted with the petition. The request should be made in writing and addressed to: Mail Stop 16, Director of the U.S. Patent and Trademark Office, P. O. Box 1450, Alexandria, VA 22313-1450. A copy of this decision should accompany petitioner's request.

Further correspondence with respect to this matter should be addressed as follows:

- By mail:** Mail Stop PETITION
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Post Office Box 1450
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- By hand:** U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314
- By FAX:** (571) 273-8300 - ATTN: Office of Petitions
- By internet:** EFS-Web
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at (866) 217-9197)

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3230


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